

REMARKS

At the time of the Third Office Action dated September 4, 2008, claims 1-20 were pending and rejected.

Applicants submit that the present Office Action dated April 30, 2003, has improperly been designated as final. In the statement of the rejection, the Examiner cited M.P.E.P. § 706.07(a) as the basis for making the present Office Action final and stated: "Applicant's [sic] amendment necessitated the new ground(s) of rejection presented in this Office action." However, M.P.E.P. § 706.07(a) clearly states:

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. (emphasis added)

In the First Office Action dated July 27, 2007, independent claims 1 and 13 were rejected under 35 U.S.C. § 102 as anticipated by Wolfe, and in the Second Office Action dated February 26, 2008, independent claims 1 and 13 were rejected under 35 U.S.C. § 102 based upon Gnagy. Although claims 8-9, 14, and 20 were amended in the First Amendment dated October 29, 2007, claims 1 and 13 have never been amended. However, in the present Third Office Action, claims 1 and 13 are rejected under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer. Thus, the Examiner has rejected claims 1 and 13, which were not amended, on newly cited art (i.e., Shafer). Therefore, despite the amendments to claims 8-9, 14, and 20, it is improper under M.P.E.P. § 706.07(a) for the Examiner to designate the present Third Office Action as final. On this basis, Applicants respectfully solicit withdrawal of the finality of the present Office Action.

CLAIMS 9-12 ARE REJECTED UNDER 35 U.S.C. § 101

On page 2 of the Second Office Action, the Examiner asserted that the claimed invention, as recited in claims 9-12, is directed to non-statutory subject matter. This rejection is respectfully traversed.

Applicants substantial arguments on pages 2 and 3 of the Second Response. However, the Examiner did not respond to these arguments. In this regard, the Examiner is referred to M.P.E.P. § 707.07(f), entitled "Answer All Material Traversed," which clearly states that upon Applicants traversing the Examiner's rejection, "the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Although the Examiner has repeated the rejection, the Examiner has not answered the substance of Applicants' arguments. Thus, the Examiner has failed to follow the specific directions of the M.P.E.P. in this matter.

**CLAIMS 1-2, 7, 9, 11, 13-14, AND 19 ARE REJECTED UNDER 35 U.S.C. § 102 FOR
OBVIOUSNESS BASED UPON GNAGY ET AL., U.S. PATENT NO. 7,058,633 (HEREINAFTER
GNAGY), IN VIEW OF SHAFER (U.S. PATENT PUBLICATION NO. 2002/0191619)**

On pages 4-6 of the Second Office Action, the Examiner asserted that Gnagy discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR

International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis in the paragraph spanning pages 4 and 5 of the Second Office Action, the Examiner appears to be employing rationale (G). If the Examiner is not relying upon rationale (G), Appellants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines, the following findings of fact must be articulated by the Examiner:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure

that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Upon reviewing the Examiner's analysis in view of the requirements discussed above necessary for the Examiner to establish a *prima facie* case of obviousness, Applicants recognize several deficiencies in the Examiner's analysis.

Claims 1, 9, and 13

Each of independent claims 1, 9, and 13 recite a limitation comparable to determining the operation of content block logic. However, referring to page 3 of the Third Office Action, the Examiner did not identify a particular passage within Gnagy that allegedly teaches this limitation. Therefore, the Examiner has failed to properly characterize the scope and content of the applied prior art.

Applicants note that this same argument was also presented on page 4 of the Second Response since the Examiner did not identify a particular passage within Gnagy that allegedly teaches this limitation. However, despite the fact that these arguments still apply to the present rejection, the Examiner did not respond to these arguments in the Third Office Action. Again, the Examiner is referred to M.P.E.P. § 707.07(f), which also states that even if the arguments are moot in view of the new ground(s) of rejection, the "examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied" (emphasis added). Thus, the Examiner has again failed to follow the direction of the M.P.E.P. in responding to Applicants' arguments.

Claims 9 and 13

Claims 9 and 13 also recite "said replacement with said alias circumvents the operation of said content blocking logic." On page 3 of the Third Office Action, the Examiner admitted that Gnagy fails to teach this limitation. Then Examiner asserted the following:

The general concept of replacement with said alias circumvents the operation of said content blocking logic is well known in the art as taught by Shafer. Shafer discloses replacement with said alias circumvents the operation of said content blocking logic. ... [the Examiner's word-for-word

reproduction of paragraph [0041] omitted] ... It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gnagy to include replacement with said alias circumvents the operation of said content blocking logic in order to provide backup files for the original file in the event the original file is corrupted.

Applicants have carefully reviewed the Examiner's cited passage with Shafer and conclude that this passage is entirely silent as to the limitations for which the passage is being relied upon to teach. This passage fails to mention (i) replacement with an alias; (ii) content blocking logic; and (iii) replacement with alias circumvents the operation of the content blocking logic. Why the Examiner believes paragraph [0041] teaches these limitations is a complete mystery to Applicants.

As to the Examiner's alleged motivation for this combination (i.e., "to provide backup files for the original file in the event the original file is corrupted"), the Examiner has failed to establish any nexus between the teachings relied upon within Shafer for the proposed modifications to the Gnagy and the alleged benefit of "to provide backup files for the original file in the event the original file is corrupted." Moreover, Shafer is silent as to both "backup files" and a discussion of "in the event the original file is corrupted." As such, Appellants are unclear where this alleged motivation to modify Gnagy in view of Shafer is supported by the applied prior art.

For above-described reasons, Applicants respectfully submits that the imposed rejection of claims 1-2, 7, 9, 11, 13-14, and 19 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Schafer is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIM 8 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN
VIEW OF SHAFER, WOLFE, U.S. PATENT NO. 6,397,246, AND IWAMOTO ET AL., U.S. PATENT
NO. 5,715,462 (HEREINAFTER IWAMOTO)**

On pages 7 and 8 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer, Wolfe, and Iwamoto to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 8 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer. The additional references to Wolfe and Iwamoto does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Shafer, Wolfe, and Iwamoto, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 8 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer, Wolfe, and Iwamoto is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIM 20 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY
IN VIEW OF SHAFER, WOLFE AND IWAMOTO**

On pages 9 and 10 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Wolfe and Iwamoto to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 20 depends ultimately from independent claim 13, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 13 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer. The additional references to Wolfe and Iwamoto does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Shafer, Wolfe, and Iwamoto, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 20 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer, Wolfe, and Iwamoto is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 3 AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN VIEW OF SHAFER AND BEAUMONT, U.S. PATENT PUBLICATION NO. 2002/0169890

On pages 10 and 11 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer and Beaumont to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 3 and 15 depend ultimately from independent claims 1 and 13, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 13 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer. The tertiary reference to Beaumont does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Shafer and Beaumont, the proposed combination of references would not yield the claimed invention.

Applicants, therefore, respectfully submit that the imposed rejection of claims 3 and 15 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer and Beaumont is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 4 AND 16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN VIEW OF SHAFER AND META

On page 10 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer and Meta to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 4 and 16 depend ultimately from independent claims 1 and 13, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 13 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer. The tertiary reference to Meta does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Shafer and Meta, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 4 and 16 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer and Meta is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIM 5 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN
VIEW OF CAI, U.S. PATENT PUBLICATION NO. 2004/0172468, AND PRABHAKAR ET AL., U.S.
PATENT PUBLICATION NO. 2005/0010662 (HEREINAFTER PRABHAKAR)

On pages 12 and 13 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer, Cai and Prabhakar to arrive at the claimed invention. This rejection is respectfully traversed.

To teach the claimed "determining that content blocking has occurred when a difference between said references and said requests exceeds a threshold value," the Examiner relied upon paragraph [0042] of Prabhakar to teach this limitation. Applicants respectfully disagree. The paragraph in Prabhakar cited by the Examiner merely describes the general concept of tracking applications. However, completely absent from the Examiner's cited passage in Prabhakar is any mention of determining content blocking has occurred based upon a threshold value being exceeded. Applicants, therefore, respectfully submit that the imposed rejection of claim 5 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer, Cai, and Prabhakar is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants note that this same argument was also presented in the Second Response. However, despite the fact that these arguments still apply to the present rejection, the Examiner did not respond to these arguments in the Third Office Action. Again, the Examiner is referred to M.P.E.P. § 707.07(f), which also states that even if the arguments are moot in view of the new ground(s) of rejection, the "examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied" (emphasis added). Thus, the

Examiner has failed to follow the direction of the M.P.E.P. in responding to Applicants' arguments.

CLAIM 6 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN VIEW OF SHAFER AND PRABHAKAR

On page 14 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer and Prabhakar to arrive at the claimed invention. This rejection is respectfully traversed.

Similar to claim 5, claim 6 is also directed to the concept of determining that content blocking has occurred. The Examiner's reliance upon paragraph [0043] of Prabhakar to teach this limitation is misplaced. The paragraph in Prabhakar cited by the Examiner merely describes determining when an application is in a redirect loop and not whether or not content blocking has occurred. Applicants, therefore, respectfully submit that the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer and Prabhakar is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants note that this same argument was also presented in the Second Response. However, despite the fact that these arguments still apply to the present rejection, the Examiner did not respond to these arguments in the Third Office Action. Again, the Examiner is referred to M.P.E.P. § 707.07(f), which also states that even if the arguments are moot in view of the new ground(s) of rejection, the "examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied" (emphasis added). Thus, the

Examiner has failed to follow the direction of the M.P.E.P. in responding to Applicants' arguments.

**CLAIM 10 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY
IN VIEW OF SHAFER AND KINGBERG, U.S. PATENT PUBLICATION NO. 2003/0061515**

On page 15 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer and Kingberg to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 10 depends ultimately from independent claim 9, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 9 under 35 U.S.C. § 103 for obviousness based upon Gnagy and Shafer. The additional reference to Kingberg does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Shafer and Kingberg, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer and Kingberg is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIM 12 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY
IN VIEW OF SHAFER, OMOIGUI, U.S. PATENT NO. 6,694,352, IN VIEW OF KHANNA, U.S.
PATENT NO. 7,110,407**

On pages 15 and 16 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Shafer, Omoigui, and Khanna to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 12 depends ultimately from independent claim 9, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 9 under 35 U.S.C. § 103 for obviousness based upon Gnagy and Shafer. The additional references to Omoigui and Khanna do not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Shafer, Omoigui, and Khanna, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 12 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Shafer, Omoigui, and Khanna is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 1, 2008

Respectfully submitted,

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